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09/177,251	10/22/1998	ERIC C. ANDERSON	1062P/P180	2859

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EXAMINER

AGGARWAL, YOGESH K

ART UNIT	PAPER NUMBER
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2615

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/177,251
Filing Date: October 22, 1998
Appellant(s): ANDERSON, ERIC C.

Stephen G. Sullivan
Reg. No. 38,329
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/18/2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

There were no proposed amendments to the claims in response to the final office action. Appellant's remarks after final rejection filed on 02/23/2004 have been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-7, 9-22, 28, 30, 32,34, 36, and 38-42 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). Claims 1-7 and 28 are one group, claims 9, 30, and 39 are a second group, claims 10-18, 32, and 40 are a third group, claims 19-21, 34, and 41 are a fourth group, and claims 22, 36, and 42 are a fifth group. Therefore, claims 1-7, 9-22, 28, 30, 32, 34, 36, and 38-42 constitute five (5) separate groups.

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(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

6,067,114	OMATA ET AL.	05-2000
4,826,301	IKEMORI	05-1989
4,825,235	WAKABAYASHI ET AL.	04-1989
5,825,016	NAGAHATA ET AL.	10-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims as set forth in the final rejection, Paper No. 11. In summary:

Claims 1-2, 4-7, 10-11, 13-21, 28, 32, 34, 38, and 40-41 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Omata (US Patent No. 6,067,114) in view of Ikemori (US Patent No. 4,826,301) and in further view of Wakabayashi (US Patent # 4,825,235).

Claims 3 and 12 are rejected under 35 U.S.C 103 (a) as being unpatentable over Omata (US Patent No. 6,067,114) in view of Ikemori (US Patent No. 4,826,301) and Wakabayashi (US Patent # 4,825,235) and in further view of Nagahata (US Patent # 5,825,016).

Claims 9, 22, 30, 36, 39 and 42 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Omata (US Patent No. 6,067,114) in view of Ikemori (US Patent No. 4,826,301) and Nagahata (US Patent # 5,825,016) and in further view of Wakabayashi (US Patent # 4,825,235).

(11) Response to Argument

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Appellant argues that the Omata patent fails to teach shifting the focus zone only if it is determined that the focus zone can be so shifted (Brief, Bottom, Page 8). The examiner respectfully disagrees.

Examiner notes that the word “only” has not been recited in claims. Examiner notes that Omata clearly teaches shifting of focusing while focusing of the image by the focusing lens (col. 4 lines 12-15). It would be inherent that this operation would be done only if it is determined that focus zone can be so shifted.

Appellant argues that the Omata patent fails to teach the features recited in the claims, particularly, the limitations of “setting the aperture size without shifting the focus zone after the focus zone has been shifted if it is determined that the focus zone can be shifted so that the at least one object is out of focus and adjusting the aperture size to shorten the focus zone if it is determined that shifting the focus zone alone is not sufficient for the at least one object to be out of focus” (Brief, Top, Page 9). However, the examiner relies upon the combination of Omata, Ikemori and Wakabayashi to teach these features and not Omata alone. Therefore, in response to appellant’s arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As a matter of fact, Wakabayashi (in combination with Omata and Ikemori) has been used for the teaching of setting the aperture size separately from a focus adjustment to improve the soft tone effect (col. 18 lines 45-48). “Improving the soft-tone effect” signifies that a soft-focus or soft-tone already achieved is not adequate. Ikemori moves a focusing lens to achieve a soft focus (col. 11 lines 54-57).

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Ikemori can only do this if it is determined that the focus zone can be shifted.

Wakabayashi is relied upon for the broad teaching of improving an existing soft focus condition by manipulating only the aperture. Therefore in the combination of Ikemori and Wakabayashi, Wakabayashi teaches setting the aperture size without shifting the focus zone because the focus zone has already been shifted in Ikemori. It is well known by photographers to vary both focusing and aperture to produce an overall desired soft-focus effect and thus the use of the technique in Wakabayashi following the lens movement in Ikemori would have been obvious to one skilled in the art. Wakabayashi teaches to vary the aperture size if it is determined that an existing soft-tone effect is not sufficient. Thus in the combination of Ikemori and Wakabayashi, if the soft tone effect provided in Ikemori is not adequate, one skilled in the art would be taught by Wakabayashi to then vary the aperture.

Appellant argues that although Ikemori patent teaches a focus zone shift is detected and compensated for, Ikemori does not determine whether the focus zone can be shifted enough so that object(s) are sufficiently out of focus (Brief, Middle, and page 9). The Examiner respectfully disagrees with the appellant's assessment of the reference. The Examiner relies upon the combination of Omata, Ikemori and Wakabayashi to teach these features and not Ikemori alone. Therefore, in response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In Ikemori the focusing zone has been shifted to produce a soft focusing effect (col. 11 lines 54-57). Wakabayashi is relied upon for the broad

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teaching of improving an existing soft focus condition by manipulating only the aperture. As discussed previously it would have been obvious from Wakabayashi to vary the aperture size to decrease the depth of field if it is determined that shifting the focus zone alone is not sufficient (which is an improvement over Ikemori) by improving the soft-tone effect (col. 18 lines 45-48).

Appellant argues that the Ikemori patent fails to teach or suggest setting the aperture size without shifting the focus zone after the focus zone has been shifted if it is determined that the focus zone can be shifted so that the at least one object is out of focus and adjusting the aperture size to shorten the focus zone if it is determined that shifting the focus zone alone is not sufficient for the at least one object to be out of focus (Brief, Bottom, page 9). The Examiner relies upon the combination of Omata, Ikemori and Wakabayashi to teach these features and not Ikemori alone. Therefore, in response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As a matter of fact, Wakabayashi (in combination with Omata and Ikemori) has been used for the teaching of setting the aperture size to improve the soft tone effect without shifting the focus zone. "Improving the soft-tone effect" signifies that a previous soft-focus or soft-tone has already been achieved but is not adequate. In the combination of references, Ikemori moves the focusing lens i.e. shifting the focusing zone (col. 11 lines 54-57), and can only do this if it is determined that the focus zone can be shifted. The Examiner notes that the effect of determining a soft focus is to have at least one object out of focus.

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Wakabayashi teaches setting an aperture size without shifting the focus zone to improve a soft focus effect. Thus in the combination of Ikemori and Wakabayashi, Wakabayashi is relied upon to teach varying an aperture size to improve soft tone if it is determined that shifting the focus zone alone (as taught by Ikemori) is not sufficient. Therefore shifting of the focus zone so that the at least one object is out of focus is taught by Ikemori and adjusting the aperture size if it is determined that shifting the focus zone alone is not sufficient for the at least one object to be out of focus is being taught by Wakabayashi. It is well known by photographers to vary both focusing and aperture to produce an overall desired soft-focus effect and thus the use of the technique in Wakabayashi following the lens movement in Ikemori would have been obvious to one skilled in the art.

Appellant argues that although Wakabayashi describes altering the size of the aperture, there is no indication that Wakabayashi does so after the focus zone has been shifted or such that no shift occurs. Instead, Wakabayashi describes setting the aperture value to control the size of the focus zone. However, the cited portion of Wakabayashi fails to mention setting the aperture size after the focus zone is shifted. More specifically, the cited portion of Wakabayashi further fails to mention setting the aperture size such that the focus zone is not shifted. Instead, the cited portion of Wakabayashi merely indicates that the size of the focus zone and, therefore, the soft focus is controlled through the use of the aperture size. There is no indication in Wakabayashi that the focus zone may be, shifted and the aperture set without shifting the previously set focus zone (Brief, Top, Page 10). The Examiner relies upon the combination of Omata, Ikemori and Wakabayashi to teach these features and not Ikemori alone. Therefore, in response to appellant's arguments against the references individually, one cannot show

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nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner notes that Ikemori shifts the focus zone by shifting the image plane to provide soft-focusing (col. 11 lines 54-56) and Wakabayashi changes the aperture size to improve upon the soft-focusing (soft-toning) effect by only moving the aperture size without moving the focus zone and only after the focus zone has been shifted in Ikemori. Ikemori and not Wakabayashi have taught therefore "shifting of the focus zone". To further improve upon the soft-focusing effect of Ikemori, Wakabayashi teaches moving an aperture (col. 18 lines 45-48).

Appellant argues that Examiner's conclusion that because the method and system shift focus zone sufficiently to create a soft focus, "the depth of field is [or has been] decreased or increased as necessary, the focus zone is correspondingly being shifted. If the depth of field is at the desired position, it no longer needs to be adjusted, and the focus zone as well is not shifted." Thus, the Examiner seems to argue that Wakabayashi teaches the recited setting of the aperture because the aperture would not need to be further changed. However, as recited in claims 1, 10, and 19, the aperture is set without shifting the focus zone. Thus, claims 1, 10, and 19 specifically recite setting the aperture size, not maintaining the aperture size already achieved. Instead, the aperture size may be changed while maintaining the focus zone (Brief, Bottom, page 10). As discussed previously, Wakabayashi sets the aperture without shifting the focusing zone to improve the soft-tone effect because the required shifting of the focusing zone is being done in Ikemori. In the combination of Ikemori and Wakabayashi, Wakabayashi improves a soft

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tone effect not by moving the focusing zone further (as it has already done in Ikemori) but only setting the aperture value (col. 18 lines 45-48). Consequently shifting the focus zone is done in Ikemori and setting the aperture without shifting the previously set focus zone (by Ikemori) is done in Wakabayashi.


Appellant argues that the Examiner further seems to argue that Wakabayashi uses the aperture change in order to create a soft focus. Wakabayashi expressly states that a soft filter is used. Wakabayashi then sets the aperture to improve (not obtain) the soft-tone. Wakabayashi, col. 18, lines 46-48. Appellant also disagrees that Wakabayashi sets the aperture to obtain a soft focus. Instead, the soft focus of Wakabayashi is created using a soft filter, then improved using by setting the aperture size. As a result, Wakabayashi would not set the aperture size without shifting the focus zone after it has been determined that the focus zone can be shifted sufficiently to provide a soft focus and the focus zone has been so shifted (Brief, Top, Page 11). The Examiner respectfully disagrees. Wakabayashi is being used for the broad teaching that a soft focusing effect be improved by using an aperture variation, which is old and well known to photographers.

Finally Appellant argues that Nagahata does not teach whether the focus zone can be shifted enough to ensure that certain object(s) are out of focus, shifting the focus zone if it is determined that the focus zone can be sufficiently shifted, and adjusting the aperture size without further shifting the focus zone if the desired soft focus can be achieved with a focus zone shift alone (Brief, Page 12 and 13). However Nagahata is not being used to teach the features attributed to Omata, Ikemori and Wakabayashi.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



Yogesh Aggarwal
Assistant Examiner
Art Unit 2615

YKA

September 2, 2004

Conferees

Andrew Christensen, SPE

Chris Kelley, SPE

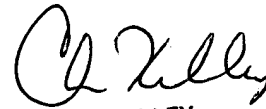
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